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Applicant(s): John S. Yates, Jr., et al.

Serial No.: 09/385,394

Art Unit: 2183

Filed: August 30, 1999

Examiner: Richard Ellis

Title: COMPUTER WITH TWO EXECUTION MODES

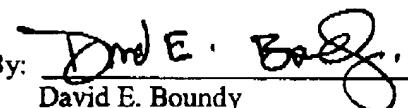
AFTER FINAL – EXPEDITED PROCEDURE

I hereby certify that the attached

- This FAX cover sheet
- Request for Withdrawal of Finality of Office Action
- Response to Office Action of October 1, 2002

along with any paper(s) referred to as being attached or enclosed) are being transmitted by facsimile on December 2, 2002 to the Commissioner for Patents, Box AF, Washington, D.C. 20231.

Dated: December 2, 2002

By: 
 David E. Boundy
 Registration No. 36,461

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PATENT

DOCKET NO. 5231.03-4000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Art Unit: 2183

Examiner: Richard Ellis

Serial No.: 09/385,394

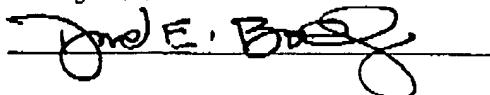
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REQUEST FOR WITHDRAWAL OF FINALITY OF OFFICE ACTION

Applicant observes that the Action of October 1, 2002 (the "October Action") was prematurely made final. Pursuant to MPEP § 706.07(c) and (d), Applicant requests that the premature finality of the October Action be withdrawn, and that the Amendment in Response to Office Action filed herewith be entered as of right.

I. The October Action introduces several new grounds of rejection of unamended claims

An Action may not be made final when it introduces a new ground of rejection, where the claim is unamended, or where the new ground was not necessitated by an amendment. MPEP § 706.07(a).

In the Action of February 2002 (the "February Action"), claims 23-26 and 86 were objected to as dependent on rejected base claims, but indicated allowable. In the Action of October 2002, the allowance of these claims is withdrawn. Several of these claims are entirely unamended. Others are amended, but the reasoning stated in the October Action does not relate to the amendments, and thus the new ground of rejection was "not necessitated by an amendment."

Finality of the Action of October 2002 is premature, and should be withdrawn.

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II. Many of the purported obviousness "rejections" are too incomplete to be made final

Many of the obviousness "rejections" of both Office Actions are incomplete. MPEP § 706.07 protects applicants against piecemeal examination, forbidding a rejection from being made final when the rejection is incomplete:

Before final rejection is in order, a clear issue should be developed between the examiner and applicant. ...

No "clear issue" can be developed on an issue where all Office Actions have been entirely silent, and thus finality is premature as long as issues of *prima facie* unpatentability remain unaddressed by the Office Actions.

For example, MPEP § 2143.02 instructs that without a showing of "reasonable expectation of success," there is no obviousness rejection. As noted in footnote 2 at page 26 of Applicant's Response of June 20, 2002 (the "June Response"), there was no showing of "reasonable expectation of success" in the obviousness rejection of claim 87 in the February Action. In the October Action, the rejection of claim 87 is either incomplete in this same respect (see sections III and VI of the accompanying Response), or is a new ground of rejection. In either event, final rejection is premature.

A great many of the obviousness "rejections" of both Office Actions merely note that some structure existed in the prior art, but make no attempt to consider whether that structure, as asserted to exist in the prior art, is interrelated to other structure as recited in the claims. Without consideration of (a) the entire claim, including the interrelationships, and including limitations and interrelationships recited in parent claims, (b) a showing of "motivation to modify or combine" and (c) a showing of "reasonable expectation of success," no obviousness rejections exist.

Finality is premature and should be withdrawn.

III. A number of the rejections in the October Action are too incomplete to be made final

A number of other "rejections" of both Office Actions are incomplete, and thus not properly final.

Claims 31, 52, 64, 70, and 90 recite that "the indicator elements are stored in a table whose entries are associated with corresponding physical page frames." This limitation is nowhere addressed in either Office Action.

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Claims 81 and 122 recite that “the physical resources of the microprocessor chip are associated to the logical resources of the first and second calling conventions according to a mapping that assigns corresponding logical resources to a common physical resource when the resources serve analogous functions in the two calling conventions.” Neither Office Action mentions this claim language. These claims are not properly rejected, let alone finally rejected.

Claims 72, 109 and 115 recite an operating system coded in “an instruction set non-native to the computer providing access to a reduced subset of the resources of the computer.” The October Action fails to address this clause, for example, by showing a resource of the computer that is inaccessible to Richter’s operating system.

Claim 98, considered in the context of its parent claims, relates a “calling convention” to a number of other claim elements, but these interrelationships have not been addressed in either Action.

A number of other claims have not been addressed in either Office Action.

An incomplete rejection cannot be a final rejection.

IV. Claim 22

Claim 22 is newly-rejected on grounds not necessitated by amendment.

Claim 22 was not addressed in the February Action, except a *pro forma* statement that claim 22 “does not teach or define above the invention claimed in claims 1-2.” However, as pending both in February 2002 and in October 2002, claim 22 recited a limitation that is absent from claims 1 and 2: that there are two separate calling conventions, and the computer is designed to “alter the data storage content” to shift from one calling convention to the other.

Because the action of February 2002 does not “contain a complete statement of the ground of rejection” as required by MPEP § 706.07, the incorporation by reference of incomplete rejections into the October Action was improper, and prevents final rejection.

Further, the October Action now makes a first mention of this limitation of claim 22. This is a “new ground of rejection which was not necessitated by amendment to the claims.” Under MPEP § 706.07(a), finality is premature.

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V. Much of the October Action lacks "substantial evidence" and thus finality is premature

A number of points in the October Action shift ground from relying on Richter '684 to relying on the Examiner's assertion of "notorious" or "well-known" art. This shift, in itself, is so substantial that Applicant should be given "a fair opportunity to react to the rejection," MPEP § 1208.01, and thus this shift (at least with respect to the unamended claims) constitutes a "new ground of rejection" that prevents finality.

Further, now that the evidentiary basis for the rejections is clarified, it is clear that these rejections lack sufficient evidentiary basis to support final rejection. In a Memorandum of February 21, 2002 from Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy to the Patent Examining Corps, Deputy Commissioner Kunin instructed as follows:

... Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known...

It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. As the court held in *Zurko*, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support.

...

(3) If applicant challenges a factual assertion as not properly officially noticed or not properly based upon common knowledge, the examiner must support the finding with adequate evidence.

...

If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained.

As discussed in some detail in the Response to Office Action filed herewith, nearly all of the written rejections of the October Action rely extensively on "common sense that is not based on any evidence in the record" and "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based."

Until the evidence is adduced to support the positions taken in the October Action, no rejections properly exist, and finality is premature.

FROM SCHULTE ROTH & ZABEL LLP a4

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V. Conclusion

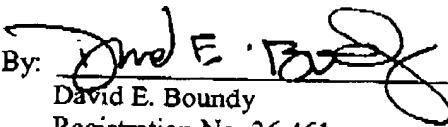
For these reasons, the finality of the Action of October 1, 2002 should be withdrawn, the accompanying Response to Office Action should be entered as of right (even without a showing of reasons under Rule 116), and the Remarks in the Response should be given full consideration.

It is believed that this paper occasions no fee. Kindly charge any fee due to Deposit Account 50-0675, Order No. 5231.03-4000.

Respectfully submitted,

SCHULTE ROTH & ZABEL, LLP

Dated: December 2, 2002

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